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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

TRAN, MAI HUONG C

ART UNIT PAPER NUMBER

2818

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,590

Applicant(s)

SU, JUN

Examiner

Mai-Huong Tran

Art Unit

2818

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 8-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

Application's election without traverse of Group I (Claims 1-7 and 19-28) in Paper No. 7 drawn to a semiconductor device is acknowledged for prosecution in the subject application. Accordingly, claims 8-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicants have the right to file a divisional application covering the subject matter of the non-elected claims.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U. S. C. § 102 (e) as being anticipated by U.S.

Patent No. 6,546,173 to Case et al.

Regarding to claim 1, Case discloses a device comprising an opto-electronic circuit 26 fabricated on a first substrate having conductive surfaces; and a package substrate 18, 20 coupled to the opto-electronic circuit at the conductive surfaces via solder bumps 30 as set forth in cols 3-4, and figs. 1 and 7A.

Regarding to claim 2, the device wherein the opto-electronic circuit further comprises at least two planar waveguides; and a heating element coupled to at least one of the two planar waveguides, the heating element coupled to the package substrate via the solder bumps (col. 1, lines 25-26, cols. 4 and 6).

Regarding to claim 3, the device further comprising a conductive strip on the package substrate coupling the heating element to the package substrate (fig. 7B).

Claim 4 is rejected under the same rationale set forth above to claim 3.

Claim 5 is rejected under the same rationale set forth above to claim 2.

Claim 6 is rejected under the same rationale set forth above to claim 2.

Claim 7 is rejected under the same rationale set forth above to claim 6.

Regarding to claim 19, Case discloses a device comprising a first substrate comprising an optoelectronic device having a first waveguide; and a package substrate coupled to the first substrate via solder bumps (fig. 7A).

Claim 20 is rejected under the same rationale set forth above to claim 19.

Claim 21 is rejected under the same rationale set forth above to claim 19.

Claim 22 is rejected under the same rationale set forth above to claim 19.

Claim 23 is rejected under the same rationale set forth above to claim 22.

Claim 24 is rejected under the same rationale set forth above to claim 23.

Regarding to claim 25, Case discloses a thermo-optic switch comprising a first substrate comprising a first waveguide; a heating element in proximity to the first waveguide; and a package substrate solder bonded to the first substrate via the heating element as set forth in cols. 1, 3-6.

Claim 26 is rejected under the same rationale set forth above to claim 25.

Claim 27 is rejected under the same rationale set forth above to claim 26.

Claim 28 is rejected under the same rationale set forth above to claim 27.

Conclusion

Any inquiry concerning this communication on earlier communications from the examiner should be directed to Mai-Huong Tran, (703) 305-1958. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM. The examiner's supervisor, David Nelms can be reached on (703) 308-4910.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Mai-Huong Tran


HOAI HO
PRIMARY EXAMINER